

Remarks/Arguments

This paper is submitted responsive to the office action mailed October 9, 2007. Reconsideration of the application in light of the accompanying remarks and amendments is respectfully requested.

Initially, it is pointed out that this office action has been made prematurely final. Withdrawal of the finality of the previous office action is respectfully requested, as is entry and full consideration of the response presented herein.

The reason for the prior office action finality being premature is that the Examiner has entered a new ground of rejection with respect to claims 5-7, 23-25 and 42-47 which was not necessitated by any amendment from the Applicant nor by any Information Disclosure Statement filed by the Applicant. Specifically, claims 5-7, 23-25 and 42-47 were amended in the prior response only to present claims 5 and 23 in independent form and independent claim 42 has not been amended in any way since the filing of the application. The Examiner had rejected these claims over a combination of Fogarty in view of Sturtz et al. (US 6,821,284). See office action of February 6, 2007, page 5. When argument was presented against this rejection, without any substantive amendments to these claims, the Examiner presented a new ground of rejection based upon two newly cited prior art patents. Clearly, this new ground of

rejection was not necessitated by any action of the Applicant. Based upon the foregoing, the finality of this office action is clearly premature and withdrawal of the finality is respectfully requested.

Turning to the rejection, the Examiner rejected claims 1-3, 15-21, 30-33 and 48-49 as anticipated by newly cited US 5,893,878 to Pierce.

Independent claim 1 has been amended responsive to this rejection to point out a clear distinction between claim 1 and the subject matter of Pierce. Claim 1 calls for an insert for attachment to a jaw-type surgical instrument. The subject matter of Pierce is clearly not an insert, but is itself an entire jaw structure. Based upon this, it is believed that claim 1 as pending in the prior response should be allowable over Pierce. Nevertheless, in order to more clearly highlight the distinction between the present claims and Pierce, claim 1 has been amended to indicate that the insert further comprises a back surface opposite to the contact surface, and a jaw attachment member on the back surface. Turning to the drawings of the case, for example any of Figures 4-9, it is readily apparent that there is a structure on the opposite surface from the contact surface. This structure is used for securing the insert in the jaw of the medical device. This is clear and well known to a person of ordinary skill in the art, and serves to clearly distinguish the subject matter of the claimed invention, drawn to insert members

for jaws of a device, from the entire jaw structure disclosed by Pierce.

Based upon the amendment to claim 1, it is submitted that claim 1 is clearly not anticipated by Pierce, and it is further submitted that claim 1 is allowable over all art of record.

Claims 2 and 3 depend from claim 1 and are submitted to be allowable based upon this dependency.

Claim 15 calls for subject matter similar to claim 1, and is submitted to be allowable over all art of record based upon the arguments set forth above. Dependent claim 16 depends from claim 15 and is submitted to be allowable based upon this dependency.

Independent claim 17 has been amended in similar fashion to claim 1 and is submitted to be allowable based upon the arguments presented above. Dependent claim 18 depends from independent claim 17 and is submitted to be allowable for the same reasons as those supporting claim 17.

Claim 19 has been amended to positively recite the insert and further specify similar structures inserted into claim 1. It is respectfully submitted that this clearly places claim 19 into condition for allowance over all art of record.

Dependent claims 20-21 depend from claim 19 and are submitted to be allowable based upon this dependency.

Claim 30 has been amended in similar fashion to independent claim 1, it is respectfully submitted that this claim also clearly defines over all art of record.

Claim 31 depends from claim 30 and is likewise submitted to be allowable over all art of record.

Claim 32 has been amended in similar fashion to claim 19, and this claim likewise is submitted to be in condition for allowance over all art of record.

Dependent claim 33 depends from claim 32 and is submitted to be allowable based upon this dependency.

Finally, independent method claims 48 and 49 have been amended to positively recite an insert and the structure of the insert in similar fashion to the amendments to claim 1. Claims 48 and 49 are submitted to clearly define patentably over all art of record.

The next ground of rejection was a rejection of claims 15-18 and 30-33 as obvious over Pierce. These claims were also rejected in the anticipation rejections discussed above. As discussed above, it is respectfully submitted that each of these claims contains subject matter which is

not disclosed or in any way obviated by Pierce, and therefore that these claims are in condition for allowance.

The next ground of rejection is a rejection of claims 5-7, 23-25 and 42-47 as being obvious over Pierce in view of US 2,706,987 to Bramstedt. The claims rejected under this ground of rejection all call for various different structures of the traction element, specifically drawn to the height of the traction elements. The Examiner concedes that this is not taught in Pierce, and instead turns to the teachings of Bramstedt to solve the deficiency. Bramstedt is directed to an insert for a surgical needle clamp. The surgical needle clamp is a drastically different device, and is used for grasping a needle during surgical procedures. Thus, the jaws of Bramstedt never grasp tissue. Furthermore, the jaws of Bramstedt do not encounter any of the important concerns encountered by inserts such as those of the present invention or even the jaws of the Pierce device. Thus, there is nothing in Bramstedt which would be considered by a person of ordinary skill in the art as being relevant to the subject matter of the present invention and/or the subject matter of Pierce, which is the safe and non-damaging grasping of tissues and vessels of the human body. Further, the structure of Bramstedt is a material having a hardness of between 53 and 70. This is an extremely hard material, and would likewise be an indication to a person of ordinary skill in the art that the Bramstedt device is not at all relevant to the teachings of Pierce and/or the subject matter of the

present invention. Thus, it is submitted that a person of ordinary skill in the art would clearly not seek to combine any teachings of Pierce and Bramstedt, as these teachings are to drastically diverse applications, specifically, the grasping of soft tissues and blood vessels on the one hand, and the firm grasping of a surgical needle for manipulation of that needle during a surgical procedure on the other hand. Claims 5-7, 23-25 and 42-47 are not at all obviated by this combination of art, because the combination of art is improper in providing any obviousness rejection under 35 U.S.C. 103(a).

Reconsideration and withdrawal of this rejection is respectfully solicited.

The next ground of rejection is a rejection of claims 8-13, 26-29 and 34-41 as obvious over Pierce, Bramstedt and US 6,484,371 to Romanko et al.

Initially, it is respectfully submitted that this combination of art fails for the same reason as the combination of Pierce and Bramstedt set forth above. Specifically, Pierce and Bramstedt are such totally diverse teachings that a person of ordinary skill in the art would under no circumstances seek to combine them. The features of the teeth of the Bramstedt disclosure would not be considered or expected to be useful in any way in the environment of Pierce.

In further connection with these claims, the Examiner has mischaracterized the prior argument from the Applicant. The Examiner summarizes that argument in a single sentence, stating that Applicant argued that "Romanko provides a different function, but the same structure". The actual argument presented was that a person of ordinary skill in the art, considering the teachings of Romanko as a whole, would not recognize these structures as having any useful contribution to the subject matter of the present invention or the subject matter of Pierce and/or Bramstedt. It is respectfully submitted that a person of ordinary skill in the art would not expect to find any useful teaching in a hook and loop fastener structure when that person of ordinary skill in the art is working in the field of surgical clips or clamps, and is considering a device such as that of the present invention and/or even a device of the diverse teachings of either Pierce or Bramstedt. Even given the diverse fields of Pierce and Bramstedt, it is respectfully submitted and urged that Romanko et al. would not be considered by a person of ordinary skill in the art as having any useful contribution of the fields of surgical clamps, be they clamps for tissue and blood vessels as in the present invention, or clamps for needles as in Bramstedt.

Based upon the forgoing, it is respectfully submitted that a person of ordinary skill in the art would clearly not combine any teachings from Romanko with Pierce or Bramstedt, and therefore the this ground of rejection

further fails to establish a proper rejection under 35 U.S.C. 103(a).

An earnest and through effort has been made to respond to each and every issue raised in the prior office action and to place this application in condition for allowance. If upon consideration of this response, the Examiner believes that further issues remain which could be resolved by telephone interview, the Examiner is invited to telephone the undersigned to discuss these issues.

This paper is accompanied by a request for extension of time as well as authorization of deposit account to pay for such extension of time. It is believed that no further fee is due. If any such fee is due please charge same to deposit account number 02-0184.

Respectfully submitted,  
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